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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/081,021      | 02/21/2002  | Jonathan Samn        | AUS920020004US1     | 1664             |

45993 7590 04/19/2005

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EXAMINER

LEROUX, ETIENNE PIERRE

|          |              |
|----------|--------------|
| ART UNIT | PAPER NUMBER |
|----------|--------------|

2161

DATE MAILED: 04/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                               |                                |  |
|------------------------------|-------------------------------|--------------------------------|--|
| <b>Office Action Summary</b> | Application No.<br>10/081,021 | Applicant(s)<br>SAMN, JONATHAN |  |
|                              | Examiner<br>Etienne P LeRoux  | Art Unit<br>2161               |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 February 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |                                                                                                                                              |                                                                                        |
|----------------------------------------------------------------------------------------------------------------------------------------------|----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                                                  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                                         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)            |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>2/21/2002</u> | 6) <input type="checkbox"/> Other: ____                                                |

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## **DETAILED ACTION**

### ***Claim Status***

Claims 1-27 are pending. Claims 1-27 are rejected as detailed below.

### ***Specification***

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required:

Claim 1 recites “parsing said retrieved contact record to obtain a search key value.” The specification of the present application does not contain a clear and concise description of the method by which the retrieved record is parsed in order to obtain a search term. For purposes of this first action on the merits, examiner assumes that an e-mail address is used as a search term per the disclosure of Chen.

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-3, 6 and 9 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 1-3, 6 and 9 are drawn to a method of maintaining a contact list. The claims are drawn solely to method steps for adding an item (telephone number) to the contact list. Such method steps can be done with a pencil and paper as disclosed by Chen in paragraph 31. Chen discloses a user who maintains a list of contacts (e.g., customers, suppliers and affiliates) in a well-known Rolodex. As is well-known in the art, Rolodexes were for many years solely a manual system. Furthermore, during examination, the claims must be interpreted as broadly as their terms reasonably allow and thus examiner maintains that fulfilling a contact list can be interpreted as “keeping a Rolodex up-to-date.” Technology is not required for a user to keep his/her Rolodex up-to-date by accessing a telephone number in a telephone directory and adding the retrieved telephone number to the appropriate record in his/her Rolodex. The claimed method steps do not define structural and functional interrelationships between elements of a computer which is required to realize the functionality of the claimed method steps and thus cause the claimed invention to be statutory. The method steps are not tangibly embodied on a computer readable medium. Only when a medium tangibly embodies a program, functions and/or instructions that are executable by file servers and/or network client computers to perform the method steps of the present invention will the claimed method steps become statutory.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for

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patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-6, 8-15, 17-24, 26 and 27 are rejected under 35 U.S.C. 102(e) as being anticipated by Pub No US 2002/0049751 issued to Chen et al (hereafter Chen).

Claims 1, 10 and 19:

Chen discloses:

accessing a contact list to retrieve a contact record [searching module 45 matches B's email address with other contact lists, paragraph 44, Fig 3];

parsing said retrieved contact record to obtain a search key value from at least one data item [searching module 45 matches user B's email address with other contact lists, paragraph 44, Fig 3];

using said search key value to retrieve from an administered contact information store at least one additional data item not already present in said contact record [server application 20 automatically brings A's profile into B's contact list, paragraph 44]

modifying said contact record to include said additional data item; and repeating said steps of accessing, parsing, using, and modifying until a set of contact records have been processed [A's profile copied to B's contact list, paragraph 44, contact list file in local memory 11b, Fig 1, paragraph 46, paragraph 31, paragraph 32].

Claims 2, 11 and 20:

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Chen discloses wherein said step of accessing a contact list comprises accessing a text file [paragraph 52].

Claims 3, 12 and 21:

Chen discloses wherein said step of accessing a contact list comprises accessing a database file [Fig 2, 22]

Claims 4, 13 and 22:

Chen discloses wherein the step of accessing a contact list comprises accessing an online address book file [user profile, paragraph 52]

Claims 5, 14 and 23:

Chen discloses wherein said step of parsing said retrieved contact record comprises extracting an email address from said retrieved contact record [paragraph 44]

Claims 6, 15 and 24:

Chen discloses wherein said step of using said search key value to retrieve from an administered contact information store comprises accessing a corporate personnel information database [paragraph 53]

Claims 8, 17 and 26:

Chen discloses wherein said step of using said search key value to retrieve from an administered contact information store comprises accessing an electronic members directory [group members, paragraph 10 and 11]

Claims 9, 18 and 27:

Chen discloses wherein said step of modifying said contact record comprises adding a telephone number to said retrieved contact record [user's profile includes a telephone number]

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 7, 16 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chen in view of Pub No US 2004/0078388 issued to Melman (hereafter Melman).

Claim 7:

Chen discloses the elements of claim 1 as noted above but does not disclose wherein said step of using said search key value to retrieve from an administered contact information store comprises accessing an electronic telephone directory. Melman discloses wherein said step of using said search key value to retrieve from an administered contact information store comprises accessing an electronic telephone directory [Fig 5]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Chen to include wherein said step of using said search key value to retrieve from an administered contact information store comprises accessing an electronic telephone directory as taught by Melman for the purpose of obtaining a telephone number of a contact. The skilled artisan would have been motivated to improve the invention of Chen per that above for the purpose of making audio contact with the person of concern

Claim 16:

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Chen discloses the elements of claim 10 as noted above but does not disclose wherein said step of using said search key value to retrieve from an administered contact information store comprises accessing an electronic telephone directory. Melman discloses wherein said step of using said search key value to retrieve from an administered contact information store comprises accessing an electronic telephone directory [Fig 5]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Chen to include wherein said step of using said search key value to retrieve from an administered contact information store comprises accessing an electronic telephone directory as taught by Melman for the purpose of obtaining a telephone number of a contact. The skilled artisan would have been motivated to improve the invention of Chen per that above for the purpose of making audio contact with the person of concern

Claim 25:

Chen discloses the elements of claim 19 as noted above but does not disclose wherein said step of using said search key value to retrieve from an administered contact information store comprises accessing an electronic telephone directory. Melman discloses wherein said step of using said search key value to retrieve from an administered contact information store comprises accessing an electronic telephone directory [Fig 5]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Chen to include wherein said step of using said search key value to retrieve from an administered contact information store comprises accessing an electronic telephone directory as taught by Melman for the purpose of obtaining a telephone number of a contact. The skilled artisan would have been



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motivated to improve the invention of Chen per that above for the purpose of making audio contact with the person of concern

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Etienne LeRoux whose telephone number is (571) 272-4022. The examiner can normally be reached on Monday – Friday from 8:00 AM to 4:30 PM.

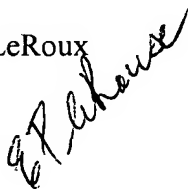
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic, can be reached on (571) 272-4023.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-2100.

Patent related correspondence can be forwarded via the following FAX number (703) 872-9306

Etienne LeRoux

4/7/2005

A handwritten signature in black ink, appearing to read 'Etienne LeRoux', is written over the printed name and date.